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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/543,331      | 04/05/2000  | Shozo Hattori        | 35.C14393           | 6706             |

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EXAMINER

NGHIEM, MICHAEL P

ART UNIT PAPER NUMBER

2863

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/543,331

Applicant(s)

HATTORI ET AL.

Examiner

Michael P Nghiem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 October 2002 and 20 November 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2,5-8,10 and 19-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,5-8,10 and 19-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

The Amendment filed on October 29, 2002 has been acknowledged.

### ***Continued Prosecution Application***

1. The request filed on November 20, 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/543,331 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Withdrawal of Allowability***

2. The indicated allowability of claims 5, 9, and 10 are withdrawn in view of the reference(s) to Boyd et al. (EP 709 211). Rejections based on the newly cited reference(s) follow.

### ***Claim Objections***

3. Claims 6 and 10 are objected to because of the following informalities:

- claim 6, "changer" (line 3) should be -- chamber --.
- claim 10, "containing" (line 1) should be -- comprising --.

Appropriate correction is required.

***Claim Rejections - 35 USC 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8 and 10/8 are rejected under 35 U.S.C. 102(b) as being anticipated by Ono et al. (EP 756 935).

Ono et al. discloses all the claimed features of the invention including:

- an ink tank (20) containing an ink absorbent an ink absorbent (24-26) for storing ink in the interior thereof and provided with a supply port (23a, 23b, 23c) for leading out ink to the outside, and an atmospheric communication port (column 5, lines 4-5) for communication with the air outside, said ink absorbent being formed by fiber material having a surface formed at least by thermoforming (column 5, line 36 – column 6, line 6), wherein two faces of said ink absorbent opposite to each other are cut faces parallel to each other in fiber direction (top and bottom cut surfaces of 45 are parallel to each other, Fig. 3a).

Claims 2, 5, 10/(2,5), and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Boyd et al. (EP 709 211).

Boyd et al. discloses all the claimed features of the invention including:

- an ink tank (Fig. 5) containing:

- an ink absorbent (130, 132, 134) for storing ink in the interior thereof and provided with a supply port (183-185) for leading out ink to the outside, and an atmospheric communication port (148, 154, 156) for communication with the air outside, said supply port being adapted to receive an ink supply portion of an ink jet head into an inside of said housing (Fig. 5),

- said ink absorbent is arranged by a fibrous material (felted foam) having an outer surface thereof thermally processed into an outer shape (page 7, lines 43-46, Figs. 6, 7) configured for containment in the interior of said ink tank (Fig. 5), and face of said ink absorbent facing said supply port of said ink tank is a non-thermally processed cut face (130 is felted in only the width direction, Abstract, lines 13-16, thus, top and bottom surfaces of foam, Fig. 7, are not treated, bottom surface faces 184, Fig. 5);

- the face (240, 242) of said ink absorbent facing the plane having the largest area on the inner face of said ink tank (Fig. 4);

- said non-thermally processed face is arranged by cutting a thermally processed face and has a hardness softer than the thermally processed face (Abstract, lines 8-10).

Even though Boyd et al. does not disclose that the face of said ink absorbent facing the plane having the largest area on the inner face of said ink tank is formed by cutting, the face of the present invention does not structurally distinguish over the face disclosed by Boyd et al.. It has been held that determination of patentability of a product is based on

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the product itself and does not depend on its method of production. In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7, 19-22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koitabashi et al. (US 5,509,140) in view of Boyd et al..

Koitabashi et al. discloses the following claimed features of the invention:

- an ink tank (1, Fig. 3) comprising:

- a supply port (opening of 1 receiving 7) for leading out ink to the outside, an atmospheric communication port (13) for communication with the air outside, a negative pressure generating member installation chamber (4) in which an ink absorbent (3) is contained, a liquid storage chamber (6) communicated with said negative pressure generating member installation chamber through a communication passage (8) to store ink to be supplied to said negative pressure generating member installation chamber, said liquid storage chamber having substantially closed with the exception of said

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communication passage (Fig. 3), and a partition wall member (5) defining said communication passage and partitioning said negative pressure generating member installation chamber and said liquid storage chamber, said supply port being adapted to receive an ink supply portion (7) of an ink jet head into an inside of said negative pressure generating member installation chamber (Fig. 3),

- said ink absorbent is arranged by a fibrous material (3), an outer surface thereof is thermally processed into an outer shape configured for containment in the interior of said ink tank (column 11, lines 58-63);

- the face of said ink absorbent facing said partition wall member (Fig. 3).

Even though Koitabashi et al. does not disclose that the face of said ink absorbent facing said partition wall member is formed by cutting, the face of the present invention does not structurally distinguish over the face disclosed by Koitabashi et al.. It has been held that determination of patentability of a product is based on the product itself and does not depend on its method of production. In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985).

However, Koitabashi et al. does not disclose:

- said ink absorbent is contained in a manner that a side face of said ink absorbent corresponding to said supply port of said ink tank is a non-thermally processed cut face;
- said non-thermally processed face is arranged by cutting a thermally processed face and has a hardness softer than the thermally processed face.

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Nevertheless, Boyd et al. discloses an ink absorbent (130, 132, 143) is contained in a manner that a side face of said ink absorbent corresponding to said supply port of said ink tank is a non-thermally processed cut face (Fig. 5) arranged by cutting a thermally processed face (Abstract, lines 8-10) for the purpose of fitting the absorbent into the ink supply port portion of the ink tank.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Koitabashi et al. with an ink absorbent as disclosed by Boyd et al. for the purpose of fitting the absorbent into the ink supply port portion of the ink tank.

### ***Response to Arguments***

6. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Contact Information***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Nghiem whose telephone number is (703) 306-3445. The examiner can normally be reached on M-H from 6:30AM – 5:00 PM.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached at (703) 308-3126. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7724 for regular communications and (703) 308-5841 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



**MICHAEL NGHIEM**  
**PRIMARY EXAMINER**

Michael Nghiem

January 28, 2003